

REMARKS

Claims 1-36 are pending and under consideration.

In the outstanding Office Action, claims 1-36 were rejected as being unpatentable over U.S. Patent 6,615,240 to Sullivan et al. (hereinafter "Sullivan") in view of U.S. Patent No. 6,450,500 to Miller (hereinafter "Miller"). Applicant's representative called the Examiner to check the second reference (Miller) since arguments in the outstanding Office Action were related to the reference Friedland and not to Miller. The Examiner confirmed that citing Miller was a clerical error and that actually Miller should be replaced with U.S. Patent No. 6,449,601 to Friedland et al. ("Friedland").

OBJECTION TO THE TITLE

In response to the objection to the title, the title is amended herewith to be more clearly directed to the claimed invention. Accordingly, Applicant believes the objection to the title has been overcome.

RESPONSE TO ARGUMENTS – FAILURE TO TEACH ALL FEATURES

In the outstanding Office Action it is alleged that "displaying a point value sequentially changing independently from one or more other client machines" is disclosed in Friedland col. 2, line 32-35, lines 59-63 and col. 3, lines 32-37. Applicant respectfully disagrees.

In Friedland col. 2 lines 32-35, it is stated "The price points in quantity lots typically decrease as the minimum quantity constraint increases, allowing the auctioneer to sell small numbers of units at retail-like values and large numbers of units at wholesale-like values within the same lot." The price points of Friedland are not the same as the point value in the present application. The price points in Friedland are prices as explained in col. 2, lines 13-18. The point value in the present application serves to motivate a potential client to use non-chargeable tentative service for a period of time in order to become accustomed to the service and determine whether the service meets the client's requirements and expectations, and also to give the client an incentive to register for the regular service so as not to waste his acquired point value (see Specification, page 36, lines 19-25).

In Friedland col. 2, lines 59-63, the following are disclosed: "...remote bidders' identities; and (5) a need for quickly determining any changes in the sequence of lots and lot assignments that occur during the course of a live auction and distributing information about the changes to remote bidders." Although the lines do contain the words "changes" and "sequence" the paragraph is unrelated and irrelevant to "displaying a point value sequentially changing

independently from one or more other client machines.” The portion of Friedland cited above actually is part of a list of problems related to Internet-based, real-time auction systems. Reciting a problem is not a teaching useful for somebody looking for a solution. In the second indicated portion of Friedland from col.2, the changing quantity is lots of products while in the first indicated portion of Friedland the changing quantity is price point (i.e. price). Merely because there is a quantity changing does not mean that the cited portions of Friedland teach or suggest changing a value point corresponding to a client machine “independently from one or more other client machines.”

In Friedland col. 3, lines 32-37, it is stated “...consoles, and a database that computationally mirrors the states of one or more live auctions and that stores detailed information about both on-going and upcoming auctions.” According to the above paragraph information is stored in a database, but this information is not displayed.

Friedland does not teach or suggest “displaying a point value sequentially changing independently from one or more other client machines” because:

1. None of the indicated paragraphs of Friedland refer to **displaying** a changing value;
2. The **point value** is not a concept similar to either price point or lots;
3. Stating a problem is not the same as teaching a solution.

RESPONSE TO ARGUMENTS – FAILURE TO PROVIDE A MOTIVATION TO COMBINE

The Examiner allegedly rebuts Applicant’s request for a motivation to combine by citing *In Re McLaughlin*, 170 USPQ 209 (CCPA 1971) which states that the test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. Applicant respectfully submits that one of ordinary skill in the art would not combine the teachings of Sullivan with the teachings of Friedland because Sullivan teaches a method for automated technical support while Friedland teaches a distributed live auction. These disparate reference teachings further raise a question of why the artisan would have considered these references for combination, a question the PTO must answer. See *In re Lee*, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002), requiring the PTO to “explain the reasons one of ordinary skill in the art would have been motivated to select the references.”

Without such a reason, a person of ordinary skill in the art would not have been motivated to perform the proposed combination except by using improper hindsight reconstruction.¹

¹ See MPEP 2141, stating, as one of the tenets of patent law applying to 35 USC 103, that “[t]he references must be

Even if the combination of the Sullivan and Friedland patents is assumed to be proper, the combination fails to teach every element of the claimed invention. Specifically, the combination fails to teach the claimed "displaying a point value sequentially changing independently from one or more other client machines." Accordingly, Applicant respectfully traverses, and requests reconsideration of, this rejection based on these patents.²

CONCLUSION

In view of the above discussion, independent claims 1, 7, 14, 20, 27, and 32 are believed to be non-obvious and patentable over the applied prior art. Specifically, at least

- "a point value display section for displaying a point value sequentially changing independently from one or more other client machines as a time available in a regular service passes by when said tentative service utilization section is utilizing a tentative service" recited in claim 1 and 14,
- "said regular service providing section is adapted to provide a service independently from one or more other client machines corresponding to a point value" and "said point value sequentially changes as time passes" recited in claim 7, 20 and 32, and
- "calculating a point value independently from one or more other user machines corresponding to said tentative service utilization time lapse up to a moment when said regular service utilization procedure was accepted" and "said point value sequentially changes while the tentative service is provided to the user machine" recited in claim 27 ,

are not taught or suggested by the cited prior art.

Claims 2-6, 8-13, 15-19, 21-26, 28-31, and 33-36 and are patentable at least because each depends from an allowable base claim. The dependent claims are moreover patentable by including features not taught or suggested by the prior art references. For example, claims 2, 15, 21, 28, and 33 recite a point value sequentially increasing as time passes by. In the outstanding Office Action at Page 5, col. 2, lines 32-35, lines 59-63, col. 3, lines 32-37 and col. 7, lines 4-20 are indicated as portions of Friedland that disclose this feature. As discussed above col. 2, lines 32-35, lines 59-63, col. 3, lines 32-37 at most point out a quantity (price point or lots) **decreasing**

viewed without the benefit of impermissible hindsight vision afforded by the claimed invention."

² See MPEP 2142 stating, as one of the three "basic criteria [that] must be met" in order to establish a *prima facie* case of obviousness, that "the prior art reference (or references when combined) must teach or suggest all the claim limitations," (emphasis added). See also MPEP 2143.03: "All words in a claim must be considered in judging the patentability of that claim against the prior art."

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in time. In Friedfiled col. 7, lines 4-20, the state transition diagram of FIG. 2 is discussed and the indicated portion does not teach or suggest the point value sequentially increasing in time.

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

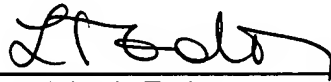
Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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